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EXAMINER

JONES, DAVID

ART UNIT PAPER NUMBER

2622

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/767,731

**Applicant(s)**

YAMAMOTO, NOBUYOSHI

**Examiner**

David L Jones

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3, 4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 1/24/01 was filed with the application on 1/24/01. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.
3. The information disclosure statement (IDS) submitted on 9/20/02 was filed after the filing date of the application on 1/24/01, before a first action on the merits. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Objections***

4. Claim 4 is objected to because of the following informalities: the word titles is misspelled as "tiles". Appropriate correction is required.
5. Claims 7 and 8 are objected to because of the following informalities: both claims 7 and 8 recite the same language exactly. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 16 recite the limitation "the Internet data" in line 6 of both claims. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 4, 7-8, 11-12, 14-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanabe (JP 11-355498, supplied in IDS) and further in view of Disanto et al. (US 5,835,577).

**Regarding claim 1**, Tanabe teaches a portable computer system that includes:

a radio unit communicating (fig. 1, #1) with a terminal apparatus which can receive internet data;

A print unit (page 3, lines 1-6) printing a second portion other than said first portion of said one of said internet data received by said radio unit from said terminal apparatus, wherein said second portion (fig. 7, #213) is not displayed by said display unit, Tanabe teaches that the system displays the web address for printing and then prints the whole page.

However, Tanabe does not explicitly teach that the print device has a display of its own.

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Disanto et al. teaches a device that is able to interact with wireless devices, and has a display (fig. 1, #104, column 5, lines 1-10). In column 5, lines 40-55, Disanto et al. teaches that the device provides for receiving messages over the internet or other interconnected computers, such as email messages, as well as functional access to the internet or other interconnected computers. Further, in column 7, lines 17-30, that the fax controller is permitted to access to processing through telephone or other cellular connected devices. Which includes the capability to send and receive information generated by the touch sensitive screen to interact with cordless and cellular telephones.

Tanabe and Disanto et al. are analogous art because they both are from the same field of endeavor, image processing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the display of Disanto et al. with the system of Tanabe.

The suggestion/motivation for doing so would have been to provide for access to various function of the device and manipulation of the device through the display.

Therefore, it would have been obvious to combine Disanto et al. with Tanabe to obtain the invention as specified in claim 1.

**Regarding claim 4**, Tanabe teaches (fig. 13, page 6, paragraph 72) wherein a plurality of titles of internet data is displayed, and print unit prints out the internet data on a schedule setup by the user, and if a user wishes to have something printed immediately can tell the printer.

Disanto et al. teaches that the user can manipulate the device through the display 104.

**Regarding claims 7 and 8**, Tanabe teaches (fig. 4, page 4, paragraph 47-50) a wireless printing system wherein the user has the option of changing the amount that is to be printed out

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of a webpage. It would have been obvious to one of ordinary skill in the art at the time the invention was made that if incoming data is a large amount then the system would automatically add data to multiple pages based on the amount set ahead of time.

**Regarding claim 11,** Tanabe teaches (fig. 13) that the Internet data is HTML data, because it printing data of a web page.

**Regarding claim 12,** Tanabe teaches (fig. 5, page 4, paragraph 45 and 46) a radio apparatus, wherein said first portion (printing document title, HTML web address, URL) corresponds to a portion which can be displayed by said terminal apparatus, of said internet data, and second portion (actual webpage) corresponds to a portion which can not be displayed by said terminal apparatus, of said internet data received by said terminal apparatus.

**Regarding claim 14,** Tanabe teaches (fig. 5, page 4, paragraph 45 and 46) a wireless printing system wherein said first portion corresponds to a portion other than an attachment file of an electronic mail data, Tanabe utilizes the URL of the webpage sent to be printed as the first portion.

**Regarding claim 15,** Tanabe teaches (fig. 4, page 4, paragraph 47-50) a wireless printing system wherein the user has the option of changing the amount that is to be printed out of a webpage.

**Regarding claim 16,** Tanabe teaches a communication system that includes:  
a terminal apparatus (fig. 1, 10), and wherein said terminal apparatus includes:  
a data receive unit receiving Internet data (page 4, paragraph 36-40);  
a display unit displaying (page 4, paragraph 45-46) a first portion of said received Internet data; and

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a data transfer unit transferring (page 4, paragraph 43) at least a portion of said received Internet data, and

wherein said printing apparatus includes:

a radio unit (fig. 1, #1) receiving said at least portion transferred by said data transfer unit;

a print unit printing (page 3, lines 1-6) Tanabe teaches that the system can received multiple print requests from a user of which is shown in figure 13, where two portions are displayed, only the URL. And the third portion, which is in this case the actual webpage is not displayed but will be printed out. However, Tanabe does not explicitly teach that the printing device has a display or a fax function.

Disanto et al. teaches that the multifunction device includes a facsimile (column 5, lines 27-44) and a display for interaction with the device (fig. 1, 104, column 5, lines 1-10).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the display of Disanto et al. with the system of Tanabe.

The suggestion/motivation for doing so would have been to provide for access to various function of the device and manipulation of the device through the display.

Therefore, it would have been obvious to combine Disanto et al. with Tanabe to obtain the invention as specified in claim 16.

**Regarding claim 17**, Tanabe teaches a communication system, wherein said first portion is substantially identical to said second portion as stated in claim 16, both the first and second portion would be multiple URL data.

**Regarding claim 19**, is analogous to claim 4.

10. Claims 2-3, 5-6, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanabe and Disanto et al. as applied to claims 1, 4, 7-8, 11-12, 14-17, and 19 above, and further in view of Zuili et al. (US 6,145,084).

**Regarding claim 2**, Tanabe teaches (page 5, paragraph 59, schedule printing) a storing unit storing said Internet data received from said terminal apparatus, and wherein said storing unit stores Internet data received by said radio unit from said terminal apparatus. Tanabe and Disanto do not explicitly teach that the unit is registered in the printing unit. However, it is well known in the art that for a unit to be able to interact with the system the terminal apparatus must be registered ahead of time.

Whereas, Zuili et al. teaches (column 5, lines 12-28) that for one device to interact with another that the serving device must check its database to verify that the sending device is authorized to operate within the system and it would have been obvious to one of ordinary skill in the art at the time the invention was made that if a user of device is not registered then that device would not be allowed to interact with the system, therefore, if the user or device is not able to interact then the printing device would not save any data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the ability to register devices within a system with the systems of Disanto et al. and Tanabe.

The suggestion/motivation for doing so would have been to provide the system with the capability to verify that a device or user is authorized to interact with the device or system.



Therefore, it would have been obvious to combine Zuili et al. with Tanabe and Disanto et al. to obtain the invention as specified in claim 2.

**Regarding claim 3**, Tanabe teaches (page 5, paragraph 59, schedule printing) a storing unit storing said Internet data received from said terminal apparatus, and wherein said storing unit stores Internet data received by said radio unit from said terminal apparatus. Tanabe and Disanto do not explicitly teach that the unit is registered in the printing unit. However, it is well known in the art that for a unit to be able to interact with the system the terminal apparatus must be registered ahead of time.

Whereas, Zuili et al. teaches (column 5, lines 12-28) that for one device to interact with another that the serving device must check its database to verify that the sending device is authorized to operate within the system and it would have been obvious to one of ordinary skill in the art at the time the invention was made that if a user of device is not registered then that device would not be allowed to interact with the system, therefore, if the user or device is not able to interact then the printing device would not save any data. And Zuili et al. teaches that the system is registering two devices (fig. 1, 14 and 16).

**Regarding claim 5**, Tanabe teaches (page 5, paragraph 59, schedule printing) a storing unit storing said Internet data received from said terminal apparatus, and wherein said storing unit stores Internet data received by said radio unit from said terminal apparatus. Further, Tanabe teaches in fig. 13 that a plurality of devices can interact with the printing device and outputs Internet data as have been sent to the device. Tanabe and Disanto do not explicitly teach that the unit is registered in the printing unit. However, it is well known in the art that for a unit to be able to interact with the system the terminal apparatus must be registered ahead of time.

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Whereas, Zuili et al. teaches (column 5, lines 12-28) that for one device to interact with another that the serving device must check its database to verify that the sending device is authorized to operate within the system and it would have been obvious to one of ordinary skill in the art at the time the invention was made that if a user of device is not registered then that device would not be allowed to interact with the system, therefore, if the user or device is not able to interact then the printing device would not save any data. And Zuili et al. teaches that the system is registering two devices (fig. 1, 14 and 16).

**Regarding claim 6**, Tanabe teaches (page 5, paragraph 59, schedule printing) a storing unit storing said Internet data received from said terminal apparatus, and wherein said storing unit stores Internet data received by said radio unit from said terminal apparatus. Further, Tanabe teaches in fig. 13 that a plurality of devices can interact with the printing device and outputs Internet data as have been sent to the device. Tanabe and Disanto do not explicitly teach that the unit is registered in the printing unit. However, it is well known in the art that for a unit to be able to interact with the system the terminal apparatus must be registered ahead of time.

Whereas, Zuili et al. teaches (column 5, lines 12-28) that for one device to interact with another that the serving device must check its database to verify that the sending device is authorized to operate within the system and it would have been obvious to one of ordinary skill in the art at the time the invention was made that if a user of device is not registered then that device would not be allowed to interact with the system, therefore, if the user or device is not able to interact then the printing device would not save any data. And Zuili et al. teaches that the system is registering two devices (fig. 1, 14 and 16).

**Regarding claim 18**, the claim is analogous to claim 2.

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**Regarding claim 20**, the claim is analogous to claim 3.

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanabe and Disanto et al. as applied to claims 1, 4, 7-8, 11-12, 14-17, and 19 above, and further in view of Ausems et al. (US 6,434,403).

**Regarding claim 9**, Tanabe and Disanto et al. teach a printing system whereby a wireless device can interact. Neither explicitly teaches utilizing BLUETOOTH technology.

Whereas, Ausems et al. teaches (column 6, lines 19-32) that the PDA is interacting utilizing a BLUETOOTH transceiver.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the BLUETOOTH transceiver of Ausems et al. with the systems of Disanto et al. and Tanabe.

The suggestion/motivation for doing so would have been to provide the ability to interact with other devices via the short-range transceiver.

Therefore, it would have been obvious to combine Ausems et al. with Tanabe and Disanto et al. to obtain the invention as specified in claim 9.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanabe and Disanto et al. as applied to claims 1, 4, 7-8, 11-12, 14-17, and 19 above, and further in view of Izumi et al. (US 6,728,534).

**Regarding claim 10**, Tanabe and Disanto et al. teach a printing system whereby a wireless device can interact. Neither explicitly teaches utilizing PIAFS technology.

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Whereas, Izumi et al. teaches (column 14, lines 13-35) a link between the controller 228 and the PIAFS card of the device for interaction.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the PIAFS technology of Izumi et al. with Tanabe and Disanto et al.

The suggestion/motivation for doing so would have been to provide a highly expandable radio communication apparatus, which enable adding functions of a terminal adapter and PHS master unit to a conventional facsimile apparatus (column 3, lines 5-10).

Therefore, it would have been obvious to combine Izumi et al. with Tanabe and Disanto et al. to obtain the invention as specified in claim 10.

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanabe and Disanto et al. as applied to claims 1, 4, 7-8, 11-12, 14-17, and 19 above, and further in view of Jamtgaard et al. (US 6,430,624).

**Regarding claim 13,** Tanabe and Disanto et al. teach a printing system whereby a wireless device can interact. Neither explicitly teaches utilizing I-MODE technology.

Whereas, Jamtgaard et al. teaches (column 1, lines 47-59) that a number of markup languages are being used throughout the world for PDA and telephone use, such as HDML, WML, WINDOWS CE, and I-MODE in use in Japan.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the I-MODE technology of Jamtgaard et al. with the system of Tanabe and Disanto et al.

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The suggestion/motivation for doing so would have been to provide an effective wireless presence, supporting a multitude of different information appliances, different protocols, different markup languages, and different browsers.

Therefore, it would have been obvious to combine Jamtgaard et al. with Tanabe and Disanto et al. to obtain the invention as specified in claim 13.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L Jones whose telephone number is (703) 305-4675. The examiner can normally be reached on Monday - Friday (7:00am - 3:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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